



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,506	10/31/2003	Vincent Vaccarelli	LEAP:129US	9595

7590 07/12/2005

Robert P. Simpson, Esq.  
Simpson & Simpson, PLLC  
5555 Main Street  
Williamsville, NY 14221-5406

EXAMINER
----------

NGUYEN, THONG Q

ART UNIT	PAPER NUMBER
----------	--------------

2872

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/698,506

Applicant(s)

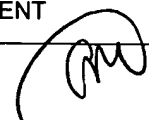
VACCARELLI, VINCENT

Examiner

Thong Q. Nguyen

Art Unit

2872



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 8-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 8-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 2, 2005 has been entered.

### ***Response to Amendment***

2. The present Office action is made in response to the amendment filed on June 2, 2005. It is noted that in the mentioned amendment, applicant has made changes to the specification and the claims. Regarding to the claims, applicant has amended claims 1, 8-9, 14-15 and 19 and canceled claim 6. The remaining claims 1-4 and 8-22 are examined in this Office action.

### ***Specification***

3. The lengthy specification which is amended by the amendment of June 2, 2005 has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

### ***Double Patenting***

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or

Art Unit: 2872

discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claim 2 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

It is noted that the two claims 1 and 2 are different by the use of the terms "information" (claim 2) and "form" (claim 1). However, since all of the printed characters contain information, thus the feature related to the information of claim 2 is inherently disclosed in the language of the claim 1.

6. Claim 8 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 3. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is

proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

See the similar reason as set forth above.

7. Claim 9 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 4. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

See the similar reason as set forth above.

***Claim Rejections - 35 USC § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1-4, 8-9 and 14-18, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson, Jr. in view of Domanik et al and Olofson (all of record).

Robinson, Jr. discloses a glass microscope slide having an opaque marking surface formed thereon. The marking surface may be formed on either end of the slide. In other words, in the embodiment as described in columns 2-4 and shown in figs. 3-4, the slide (20) comprises two marking surfaces (24) formed on the same side and on two opposite ends of the slide and an area defined between the two marking surfaces, as understood, is used to support a specimen. The marking surface is made by colored material. However, Robinson, Jr. does not

Art Unit: 2872

clearly disclose that printed information is provided on the marking surface as claimed.

The use of a slide having printed information which is printed directly on an area of a slide or printed in a label and then adhered the label onto an area of a slide wherein the printed information is the information related to the patient identification is known to one skilled in the art as can be seen in the slide provided by Domanik et al. In particular, in columns 3-4 and fig. 3, Domanik et al disclose a slide (12) having three areas in which the central area is used to support a specimen and one of the areas (20a, 20b) located on a side of the central area is used to support printed information (22) which information is in the form of a bar code (24) readable by a machine and information in the form of characters/numbers (26) readable by a human being. It is noted that the use of area supporting printed information provides a gripping area for handling the slide and thereby leaving no fingerprints on the area supporting the specimen. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the slide provided by Robinson, Jr. by utilizing printed information formed directly on the marking surface or printed information formed on a label which label is able to adhere to the marking surface as suggested by Domanik et al for the purpose of providing information of a patient having the specimen in the slide wherein the information is readable by either a human being or a machine.

The combined product as provided by Robinson Jr. and Domanik et al does not clearly disclose that one of the marking surfaces is used for information readable by a machine or a human being and the other marking surface is used to support the information representing the specimen. However, the use of two marking surfaces wherein each marking surface is used to support different information in which one marking surface is used to support information of a specimen of a patient is known to one skilled in the art as can be seen in the slide provided by Olofson. In particular, in columns 2-3 and figs. 1-3, Olofson disclose the use of two marking surfaces wherein one surface is coated by removably coating (14) in which information (28) is provided and another surface area separately from the surface contained the information (28) is used to support personal identification mark (32) such as the name of the user. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the combined product provided by Robinson Jr. and Domanik et al by using different marking areas for supporting different information as suggested by Olofson so that one marking area is used to support information related to a user having the specimen supported by the slide and the other marking surface/area for supporting other information.

10. Claims 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson, Jr. in view of Domanik et al and Olofson as applied to claim 1 above, and further in view of Speelman (of record).

The combined product as provided by Robinson, Jr. , Domanik et al and Olofson as described above does not disclose that the slide has four round corners and a surrounding edge of a trapezoidal configuration as claimed in present claims 10 and 13, respectively. However, the use of a slide made by a transparent material and is used to support a specimen wherein the slide has four round corners and a surrounding edge of a trapezoidal configuration is known in the art as can be seen in the slide provided by Speelman. In particular, in columns 1-2 and figs. 1-2, Speelman discloses a slide (10) has four round corners (20) and a surrounding edge (18) so that a use can use the slide for the purpose of smearing a specimen and for reducing any danger of cutting the fingers of the user (see column 1). Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the combined product provided by Robinson Jr., Domanik et al and Olofson by making the corners of the slide as round corners and the edge as an edge having a trapezoidal configuration as suggested by Speelman for the purpose of smearing a specimen and for reducing any danger of cutting the fingers of the user.

Regarding to the feature related to the shape of the surrounding edge of the slide, i.e., a round configuration or a triangular configuration, as recited in present claims 11-12, such a recitation is merely that of a preferred embodiment and no criticality has been disclosed. The support for that conclusion is found in the present claim 13 in which applicant has claimed that the surrounding edge of the slide has a trapezoidal configuration. It is also noted that it would have been an



obvious matter of design choice to one skilled in the art to utilize any suitable shape for the edge of the slide for the same purpose since it was decided in the Courts that a change in shape is generally recognized as being within the level of ordinary skill in the art. See *In re Dailey*, 149 USPQ 47 (CCPA 1976).

11. Claims 1 and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson, Jr. in view of Domanik et al, Olofson and the prior art described in column 2 of Patent issued to Rosenlof et al (U.S. Patent No. 5,638,459, of record).

Robinson, Jr. discloses a glass microscope slide having an opaque marking surface formed thereon. The marking surface may be formed on either end of the slide. In other words, in the embodiment as described in columns 2-4 and shown in figs. 3-4, the slide (20) comprises two marking surfaces (24) formed on the same side and on the two opposite ends of the slide and an area defined between the two marking surfaces, as understood, is used to support a specimen. The marking surface is made by colored material. However, Robinson, Jr. does not clearly disclose that printed information is provided on the marking surface as claimed.

The use of a slide having printed information which is printed directly on an area of a slide or printed in a label and then adhered the label onto an area of a slide wherein the printed information is the information related to the patient identification is known to one skilled in the art as can be seen in the slide provided by Domanik et al. In particular, in columns 3-4 and fig. 3, Domanik et al disclose a slide (12) having three areas in which the central area is used to

Art Unit: 2872

support a specimen and one of the areas (20a, 20b) located on a side of the central area is used to support printed information (22) which information is in the form of a bar code (24) readable by a machine and information in the form of characters/numbers (26) readable by a human being. It is noted that the use of area supporting printed information provides a gripping area for handling the slide and thereby leaving no fingerprints on the area supporting the specimen. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the slide provided by Robinson, Jr. by utilizing printed information formed directly on the marking surface or printed information formed on a label which label is able to adhere to the marking surface as suggested by Domanik et al for the purpose of providing information of a patient having the specimen in the slide wherein the information is readable by either a human being or a machine.

The combined product as provided by Robinson Jr. , Domanik et al and the prior art described in column 2 of patent issued to Rosenlof et al does not clearly disclose that one of the marking surface is used for information readable by a machine or a human being and the other marking surface is used to support the information representing the specimen. However, the use of two marking surfaces wherein each marking surface is used to support different information in which one marking surface is used to support information of a specimen of a patient is known to one skilled in the art as can be seen in the slide provided by Olofson. In particular, in columns 2-3 and figs. 1-3, Olofson disclose the use of

two marking surfaces wherein one surface is coated by removably coating (14) in which information (28) is provided and another surface area separately from the surface contained the information (28) is used to support personal identification mark (32) such as the name of the user. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the combined product provided by Robinson Jr., Domanik et al and the prior art described in column 2 of patent issued to Rosenlof et al by using different marking areas for supporting different information as suggested by Olofson so that one marking area is used to support information related to a user having the specimen supported by the slide and the other marking surface/area for supporting other information.

### ***Response to Arguments***

12. The amendments to the claims are not sufficient to make the device as claimed distinguish/patentable from the art of record and the applicant's arguments filed June 2, 2005, pages 8-11, have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant has argued that the combined art does not disclose all of the features recited in the present claims, the Examiner respectfully disagrees with the

applicant has respectfully invited the applicant to review the art of the record and the rejections as now repeated in this Office action.

Applicant should note that the use of slide having printed materials/information which is printed directly on an area of a slide or printed in a label and then adhered the label onto an area of a slide wherein the printed information is the information related to the patient identification is known to one skilled in the art as can be seen in the slide provided by Domanik et al. In particular, in columns 3-4 and fig. 3, Domanik et al disclose a slide (12) having three areas in which the central area is used to support a specimen and one of the areas (20a, 20b) located on a side of the central area is used to support printed information (22) which information is in the form of a bar code (24) readable by a machine and information in the form of characters/numbers (26) readable by a human being. It is noted that the use of area supporting printed information provides a gripping area for handling the slide and thereby leaving no fingerprints on the area supporting the specimen.

Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the slide provided by Robinson, Jr. by utilizing printed information formed directly on the marking surface or printed information formed on a label which label is able to adhere to the marking surface as suggested by Domanik et al for the purpose of providing information of a patient having the specimen in the slide wherein the information is readable by either a human being or a machine.

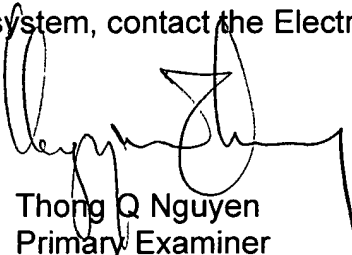
The combined product as provided by Robinson Jr. and Domanik et al does not clearly disclose that one of the marking surfaces is used for information readable by a machine or a human being and the other marking surface is used to support the information representing the specimen. However, the use of two marking surfaces wherein each marking surface is used to support different information in which one marking surface is used to support information of a specimen of a patient is known to one skilled in the art as can be seen in the slide provided by Olofson. In particular, in columns 2-3 and figs. 1-3, Olofson disclose the use of two marking surfaces wherein one surface is coated by removably coating (14) in which information (28) is provided and another surface area separately from the surface contained the information (28) is used to support personal identification mark (32) such as the name of the user. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the combined product provided by Robinson Jr. and Domanik et al by using different marking areas for supporting different information as suggested by Olofson so that one marking area is used to support information related to a user having the specimen supported by the slide and the other marking surface/area for supporting other information.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q. Nguyen  
Primary Examiner  
Art Unit 2872

\*\*\*